

PRE-APPEAL BRIEF REQUEST FOR REVIEW
- Expedited Examining Procedure -
Examining Group 2625

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Joseph A. Manico, et al.

METHOD OF DISPENSING
IMAGE BEARING PRODUCTS

Serial No.: 09/858,360

Filed: May 16, 2001

Group Art Unit: 2625

Examiner: CHARLOTTE M. BAKER

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11-7-06
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request pre-appeal brief review of the Final Office Action dated September 6, 2006, and the Advisory Action dated October 18, 2006, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. It is not clear from the Advisory Action whether the amendments filed October 5, 2006, were entered, or will be entered on Appeal. It is presumed by Applicants that the amendments will be entered on the record, and the claims are as presented in the October 5, 2006 response.

Deficiencies in the Office Action

Applicants maintain the final Office Action of September 6, 2006, was deficient for failure to address all of Applicants arguments and remarks. The Examiner argues in the Advisory Action, page 3, that the last paragraph of page 2 of the final Office Action inadvertently referenced Meyer et al. instead of Vallmajo et al., and that such typographical error should have been clear to Applicants. However, presuming this to be true, the Examiner's own comments

in the final Office Action admit neither Vallmajo et al. nor Meyer et al. teach generating an identifier associated with an image bearing product.

The feature of an identifier associated with an image bearing product is not addressed in the final Office Action, contrary to the Examiner's assertion in the Advisory Action (page 2) that the final Office Action addresses this feature at pages 2, 4, and 5. The final Office Action states at page 2:

... regarding Applicant's argument that Vallmajo et al. do not disclose generating an identifier associated with an image and image bearing product, providing the identifier to a recipient, or using the identifier to access the image and generate an image bearing product, Vallmajo et al. is not relied upon for those teachings. (Emphasis added.)

at page 4:

Vallmajo et al. fail to specifically address an identifier associated with the image and image retrieval.

Meyer et al. disclose generating an identifier for the at least one image, wherein the identifier includes information regarding the selected one or more image ...; using the identifier to retrieve the at least one image....

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an identifier for image retrieval in order to preserve the images as suggested by Meyer et al. (par. 7) and provide a more secure means of accessing images as suggested by Meyer et al. (par. 21). (Emphasis added.)

and at page 5:

Meyer et al. disclose wherein the image is retrieved from the network accessible location identified by the identifier (code number, par. 21). (Emphasis added.)

and

Regarding claim 14: Arguments analogous to those stated in the rejection of claim 1 are applicable. In addition, storing the at least one image at a network accessible location ...; using the identifier to retrieve the at least one image ... and information regarding the selected one or more image ...; and using the retrieved at least one image to generate the selected one or more image bearing products (Emphasis added.)

None of the above statements of the Examiner explain where in Vallmajo et al. or Meyer et al. an identifier associated with an image bearing product is disclosed or suggested. Only an identifier for an image or network location of an image is

disclosed in Meyer et al. The Examiner admits on the record that Vallmajo et al. does not disclose generating an identifier associated with an image bearing product.

Nowhere in the final Office Action or the Advisory Action is it indicated where either Vallmajo et al. or Meyer et al. teach or suggest associating an identifier with, or generating an identifier for, an image bearing product. Thus, the Examiner has not addressed all features of the claimed invention, or all of Applicants amendments and remarks, making the final Office Action improper for being non-responsive and incomplete.

Rejection of Claims 1, 3-14, and 16-38 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1 and 10-14 under 35 U.S.C. §103(a) over Vallmajo et al. (US 6,791,723) in view of Meyer et al. (US 2002/0116278); claims 3-7, 9, 16-20, and 22-38 are rejected further in view of Redd et al. (US 6,646,754); and 8 and 21 are rejected further in view of Liebenow (US 2002/0085840).

As indicated previously herein with regard to the deficiencies in the Office Action, it is clear from the final Office Action that neither Vallmajo et al. nor Meyer et al., taken alone or in combination, disclose or suggest an identifier associated with an image bearing product. As admitted in the Advisory Action at pages 3 and 4, neither Redd et al. nor Liebenow were relied on by the Examiner for teaching an identifier associated with an image bearing product. Thus, the final rejection is clearly in error, a prima facie case of obviousness not having been established for the claimed invention.

Finality of Office Action

Applicants maintain the finality of the first Office Action of September 6, 2006, after filing of a Request for Continued Examination (RCE) was improper. As cited by the Examiner, section 706.07(b) of the MPEP reads in part:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Note section (B) requires both subparts (1) and (2) be fulfilled for a first action final rejection to be proper. Applicants submit neither the requirements of (B)(1) nor (B)(2) have been met.

Applicants submit the claims as filed with the RCE, and the subsequent preliminary amendment, do not meet section (B)(1) because the claims were amended to state that an identifier is generated that is associated with an image bearing product. Prior to the RCE, the claims indicated the identifier was associated with the image itself. This changes a feature of the claimed invention. This feature was not previously present in any of the claims.

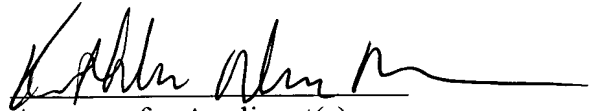
As Applicants indicated in their reply of October 5, 2006, submission of the amended claims after final would have led to an Advisory Action because the change in claimed subject matter raised new issues for consideration by the Examiner, the added feature not previously having been considered. Thus, Applicants preemptively filed an RCE to grant the Examiner the necessary time to conduct a further search, and to shorten pendency by removing the unnecessary additional steps of filing an amendment after final and receiving an advisory action before filing an RCE, which steps would waste time and resources of both Applicants and the Patent Office.

Applicants submit section (B)(2) is also not met by Applicants' submission because the amended claims are not properly rejected on the grounds that were of record in the final Office Action of April 5, 2006 before the RCE. The grounds asserted in the final Office Action of April 5, 2006, which are still maintained by the Examiner, do not establish a prima facie case of obviousness over the amended claims as submitted with the RCE and by subsequent Preliminary Amendment. None of the cited references, by the Examiner's own admission, disclose or suggest an identifier associated with an image bearing product. The details of this have been addressed elsewhere herein.

For at least the above reasons, Applicants maintain the first action Final Rejection after the RCE was improper. Finality of the rejection should be revoked, and prosecution on the merits reopened in view of Applicants last amendment submitted October 5, 2006. As indicated elsewhere herein, a prima facie case of obviousness has not been established, and the rejections should be withdrawn.

A prompt and favorable action in response to this request is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kathleen Neuner Manne', written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.